

ATTORNEY DOCKET: 47004.000030

PATENT

#12 CW
1-21-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:)
)
Barry BARTON et al.) Group Art Unit: 3628
)
Application Number: 09/391,460) Examiner: Thach H. BUI
)
Confirmation Number: 8639)
)
Filed: September 8, 1999)
)
For: Financial Advice and Strategy)
System)

RECEIVED

JAN 16 2003

RESPONSE UNDER 37 C.F.R. § 1.111

GROUP 3600

Commissioner for Patents
Washington, DC 20231

Sir:

This reply is responsive to the Office action mailed October 15, 2002 (Office action). Any fees that may be due may be charged to Deposit Account No. 50-0206. Reconsideration of the above captioned application is requested in view of the following remarks. Claims 1-16 remain pending in this application. The Office action includes rejections of claims 11 and 16 under the second paragraph of 35 U.S.C. § 112 and rejections of claims 1-16 under 35 U.S.C. § 103(a). Applicants fully respond to these rejections as follows.

I. NATURE OF JULY 2002 AMENDMENT

As an initial matter, the Office action notes in Section 1, at page 2, that applicants' "preliminary" amendment filed July 29, 2002, has been received and entered. For clarity and completeness of the record, applicants note that the July 2002 amendment was a fully responsive reply and amendment under 37 C.F.R. § 1.111 filed in response to the Office action mailed March 27, 2002. The July 2002 amendment was not a preliminary amendment filed under 37 C.F.R. § 1.115. As the Office action maintains none of the rejections or objections set forth in the March 27, 2002, Office action, applicants understand that all previous rejections and objections have been withdrawn.

II. RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 112

Section 2 of the Office action includes rejections of claims 11 and 16 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully submit that claims 11 and 16 are definite and meet the requirements of the second paragraph of 35 U.S.C. § 112 for at least the following reasons.

These rejections assert that claims 11 and 16 are indefinite because there is no clear or proper antecedent basis for certain claim terms. Applicants recognize that lack of clarity could arise where a claim refers to “said step of classifying” or “the step of classifying” where the claim contains no earlier recitation or limitation of a step of classifying. *See* M.P.E.P. § 2173.05(e). However, such a rejection is proper only where a claim recites a term introduced by “the” or “said” and the claim contains no earlier recitation of the term or an ambiguous earlier recitation of the term.

In the Office action, it is asserted that claim 11 is vague and indefinite because there is no clear or proper antecedent basis for “classifying said individual’s economic situation” as recited. “Classifying said individual’s economic situation” is the complete recitation of a step of the method set forth in claim 11. This recitation does not refer to an earlier recitation of classifying by using “the” or “said.” Accordingly, applicants respectfully submit that “classifying said individual’s economic situation” as recited in claim 11 requires no antecedent basis in the claim. Should the Examiner maintain this rejection, applicants would appreciate any suggestions for correcting any potential antecedent problems. Applicants note that “said individual’s economic situation” finds antecedent basis in the preamble of claim 11. Applicants also note that the step of classifying is supported by the specification, for example, at pages 10 through 12.

In the Office action, it is asserted that claim 16 is vague and indefinite because there is no clear or proper antecedent basis for “further refining said advice.” Claim 16 properly sets forth in the first instance “means for further refining said advice.” The term “further refining said advice” does not refer to an earlier recitation. Accordingly, applicants respectfully submit that “further refining said advice” as recited in claim 16 requires no antecedent basis. Applicants note that “said advice” finds antecedent basis in the recitation of the means for generating recited in claim 13 from which claim 16 depends. Applicants note that the

specification, for example at page 18, discloses how applicants' apparatus further refines the advice. For example, the selection of certain answers may prompt further questions, not all of which are required to be answered for the system to display relevant advice. However, the details of how the system functions need not be included in claim 16 to meet the requirements of the second paragraph of 35 U.S.C. § 112.

For at least the above reasons, applicants respectfully submit that claims 11 and 16 are definite and distinctly claim the subject matter that applicants regard as their invention. Accordingly, applicants request withdrawal of the rejections of claims 11 and 16 under the second paragraph of 35 U.S.C. § 112.

III. RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 103

In Section 3 of the Office action, claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,446,076 issued to Burkey et. al (Burkey). As an initial matter, applicants note that no single anticipatory reference has been uncovered for any claim.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim recitations. M.P.E.P. § 706.02(j).

In order to support a rejection under 35 U.S.C. § 103 based on the modification of a single reference, the Office action must include specific evidence to show *why* one of ordinary skill would be motivated to modify the reference in such a way to incorporate all of the claimed elements. See *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) ("Even when obviousness is based on a single prior art reference, there *must* be a showing of a suggestion or motivation to modify the teachings of that reference.") (emphasis added). Broad conclusory statements concerning motivation to modify, standing alone, are not sufficient to support an obviousness rejection. See *In re Freed*, 425 F.2d 785, 787, 165 USPQ 570, 571-72 (C.C.P.A. 1970) (an obviousness rejection must be based on facts, "cold hard facts"); *In re Kotzab*, 217 F.3d at 1370, 55 USPQ2d at 1317 ("Broad, conclusory statements standing alone are not 'evidence.'"). Accordingly, a statement that a modification would be an "obvious design

choice,” without factual support, is insufficient as a matter of law. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). Finally, as the absence of a suggestion to modify a reference is dispositive in an obviousness determination, a rejection which fails to provide specific evidence as to *why* one of ordinary skill would be motivated to modify the relevant reference is insupportable, as a matter of law. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997).

As set forth in greater detail below, the prior art rejection set forth in the Office action fails to meet the above requirements. In the Office action, it is acknowledged that many claim elements are not shown by Burkey. However, the Office action includes *only* broad conclusory statements that it would be obvious to modify Burkey to include elements only taught in applicants’ specification. The Office action provides no specific evidence demonstrating why one of ordinary skill would be motivated to modify Burkey. Accordingly, the rejections of claims 1-16 under 35 U.S.C. § 103 should be withdrawn.

Burkey is directed to an information management system. Burkey generally describes personalization of information based on a user profile and based on where the user is logged onto the system. The invention defined by applicants’ instant claims, relates to providing negotiation advice to a customer service representative regarding an individual’s economic situation. The instant invention is particularly useful for CSRs that are dealing with customers that are delinquent in paying recurring consumer debt payments. Burkey fails to include details related to the specific functions of applicants claimed invention. There is no suggestion in the prior art to modify Burkey to address the provision of negotiation advice.

The rejections of claims 1-16 as being unpatentable over Burkey include a number of errors. The rejections mischaracterize the single applied reference, Burkey. The rejections imprecisely refer to the limitations of the pending claims. The rejections fail to identify any specific evidence of a suggestion or motivation to modify Burkey to arrive at the claimed invention. The rejections also fail to address all the element of each pending claim and, indeed, fail to address entire claims.

A. Independent Claim 1 and Claims Depending Therefrom

Independent claim 1 sets forth a system including a first graphical user interface (GUI) comprising one or more descriptive icons, the descriptive icons representing one or more financial situations. A second GUI is displayed on the display of a computer based on selection of one of the descriptive icons. A processor is operative to generate financial payment advice.

Burkey is mischaracterized in the Office action. In the Office action it is implied that processor 110 of Burkey is operative to generate financial planning, healthcare, and personal and professional development advice. The Office action relies on column 28, line 34, through column 29, line 5, of Burkey. This section of Burkey is directed to a computer application providing users with personal web sites that are focused on delivering services in a buyer-centric world. Burkey, col. 28, ll. 34-38. Burkey merely discloses that the services addressed are intuitively organized around objectives that require coordination across several dimensions, such as financial planning, healthcare, personal and professional development, etc. Burkey, col. 28, ll. 38-43. "From the time a demand for products or services is entered, to the completion of payment, intelligent agents are utilized to conduct research, execute transactions and provide advice." Burkey, col. 28, ll. 46-49. Burkey is directed to buying products or services. There is no suggestion in Burkey to generate financial payment advice as set forth in claim 1.

It is unclear to which elements of claim 1 the Office action refers. In the Office action, it is acknowledged that Burkey does "not mention explicitly a second GUI displayed on the display of the computer having descriptive icons representing one or more financial situations such as financial payments and etc." Claim 1 sets forth that the first GUI comprises descriptive icons representing one or more financial situations. The processor recited in claim 1 is operative to generate financial payment advice. Accordingly, it appears that it is acknowledged in the Office action that Burkey fails to show 1) a first GUI *comprising one or more descriptive icons representing one or more financial situations*, 2) a second GUI, and 3) a processor operative to *generate financial payment advice*. There is no suggestion or motivation found in the prior art to modify Burkey to include these three elements.

There is no motivation to modify the teaching of Burkey as suggested in the Office action. The Office action is silent regarding a motivation to modify Burkey to include a GUI comprising one or more descriptive icons *representing one or more financial situations*. One of ordinary skill would have had no motivation to modify Burkey to include icons

representing financial situations. With regard to a second GUI, it is asserted in the Office action that it would have been obvious to modify the Burkey system to have a second set of GUIs since it is well-known in the art that it is simple to duplicate the existing set of GUIs for another one. However, claim 1 does not set forth two duplicate GUIs. To the contrary, the first and second GUIs each have particular properties related to applicants' system. Accordingly, one motivated to duplicate GUIs could not arrive at a system with the second GUI as set forth in claim 1 by duplicating any teaching of Burkey. With regard to the processor, it is asserted in the Office action that it would have been obvious to add a means for generating financial payment advice in Burkey by adding additional application software. There is no suggestion or motivation to make this modification to Burkey in either the Office action or the prior art. As Burkey is not directed to providing financial payment advice, there is no suggestion to modify Burkey in the manner suggested in the Office action.

The Office action does not address each element of claim 1. The Office action does not address that the second GUI is displayed based on selection of one of the descriptive icons. The Office action also does not address that the second GUI comprises one or more questions. It is acknowledged in the Office action that Burkey fails to show a second GUI. There is no suggestion to modify Burkey to include a second GUI that is displayed based on the selection of a descriptive icon and that comprises one or more questions.

Applicants respectfully submit that for at least the above reasons Burkey fails to suggest each limitation of claim 1. Accordingly, applicants request that the rejection of claim 1 as being unpatentable in view of Burkey be withdrawn.

Claims 2-7 depend from claim 1 and accordingly include all the limitations of claim 1. Claims 2-7 are thus patentable over Burkey for at least the reasons discussed above with respect to claim 1.

In addition, claim 3 sets forth that the system is operable to generate advice on negotiation strategies for interacting with the individual. In the Office action, it is acknowledged that Burkey does not show this element, but it is asserted that it would have been obvious to one of ordinary skill in the art to modify Burkey to provide this element. There is no support for the assertion in the Office action. There is simply no suggestion or motivation, outside applicants' own specification, to modify Burkey to generate advice on negotiation strategies.

Claim 4 sets forth that the second GUI comprises predetermined questions or predetermined answers to predetermined questions. In the Office action, it is acknowledged that Burkey does not show this element. However, it is asserted that Burkey teaches user interfaces and, therefore, that it would have been obvious to modify Burkey to include this element. Burkey merely acknowledges the development of graphical user interfaces. Burkey, col. 6, ll. 60-64. This acknowledgement provides no motivation or suggestion to modify Burkey to include a second GUI having the properties defined by claim 4.

Claim 7 sets forth that the second GUI comprises means for specifying the type of the advice generated by the system. In the Office action, it is acknowledged that Burkey does not show this element. It is noted that Burkey teaches specific GUIs. It is thus asserted that it would have been obvious to modify each GUI to have a means for specifying the type of advice. To the contrary, Burkey does not deal with types of advice and, thus, there is no suggestion or motivation to modify Burkey as suggested in the Office action.

Applicants respectfully request for at least the above reasons that the rejections of claims 2-7 be withdrawn.

B. Independent Claim 8 and Claims Dependent Therefrom

In the Office action, it is asserted that claim 8 contains features addressed in the above paragraphs, and therefore, claim 8 is rejected under the same rationale. Claim 8 sets forth a method of providing financial payment advice specifically tailored to an individual's economic situation.

Burkey fails to suggest the following steps of claim 8 for the reasons similar to those set forth above with respect to claims 1-7:

retrieving strategy data in response to the selection of a descriptive icon, said descriptive icon *representing one financial situation*;

displaying a *second GUI* on said display, said second GUI comprising *one or more questions*;

processing answers to questions generated by said system *in response to said selection of said descriptive icon, said questions related to said financial situation*;

retrieving *financial payment advice data related to said answers to said questions*; and

displaying *said financial payment advice* on said display.

Burkey fails to show these elements for the reasons acknowledged in the Office action with respect to claim 1. There is no motivation found in the prior art to modify Burkey to include these elements. The unsupported statements in the Office action that it would have been obvious to modify Burkey to include the similar elements set forth in claim 1 are insufficient to establish a *prima facie* case of obviousness for the reasons discussed above.

In the Office action, it is acknowledged that Burkey does “not mention explicitly a [sic] steps of retrieving strategy data in response to an individual’s account information.” It is unclear to what elements of claim 8 the Office action refers. It appears that it is acknowledged in the Office action that Burkey does not show the following steps of claim 8:

retrieving *the individual’s account information*;
displaying *the account information* on a first graphical user interface; and
retrieving *strategy data in response* to the selection of a descriptive icon.

It is asserted, in the Office action, that Burkey teaches a system that is capable of retrieving information from multiple databases according to an individual’s profile. It is further asserted that therefore it would have been obvious that the Burkey system is capable of retrieving information and/or strategy data in response the selection of a descriptive icon. To the contrary, Burkey suggests no strategy data and, thus, is not capable of retrieving strategy data without modification. The mere fact that Burkey can be modified does not render claim 8 obvious, because there is no suggestion of the desirability of the modification except in applicants’ own specification. There is no motivation found in the prior art to modify Burkey to retrieve an individual’s account information or strategy data as set forth in claim 8.

Applicants respectfully request that for at least the above reasons the rejection of claim 8 as being unpatentable in view of Burkey be withdrawn.

Claims 9 and 10 depend from claim 8 and accordingly include all the limitations of claim 8. Claims 9 and 10 are thus patentable over Burkey for at least the reasons discussed above with respect to claim 8.

In addition, claim 9 sets forth the step of generating advice on negotiation strategies for interacting with the individual. Claim 9 is rejected for the same reason as claim 3. There is no suggestion or motivation, outside applicants’ own specification, to modify Burkey to generate advice on negotiation strategies for the reasons set forth above with respect to claim 3.

Claim 10 sets forth the step of displaying the advice together with the questions. In the Office action, it is asserted that claim 10 addresses features addressed in claim 4. Claim 4 is not directed to displaying advice with questions. Burkey fails to show or suggest displaying advice with questions.

Applicants respectfully request for at least the above reasons that the rejections of claims 9 and 10 be withdrawn.

C. Independent Claim 11 and Claim Dependent Therefrom

Claim 11 is not specifically addressed in the prior art rejections in the Office action. Claim 11 sets forth a method for providing financial payment advice specifically tailored to an individual's economic situation. Burkey fails to show or suggest the following steps of the method of claim 11:

- obtaining information related to the *individual's financial account*;
- classifying the individual's economic situation*;
- selecting a descriptive icon, the descriptive icon *representing one financial situation*, where the descriptive icon is displayed on a first graphical user interface (GUI) displayed on a display of a computer;
- obtaining answers to questions offered in response to the selection of the descriptive icon, the questions displayed on the first GUI where the questions are related to the financial situation*;
- inputting *the answers* to said questions; and
- requesting financial payment advice* based on at least said answers to said questions.

Applicants respectfully request that for at least the above reasons the rejection of claim 11 as being unpatentable in view of Burkey be withdrawn.

Claim 12 depends from claim 11 and accordingly includes all the limitations of claims 11. Claim 12 is thus patentable over Burkey for at least the reasons discussed above with respect to claim 11.

Claim 12 sets forth specifying the type of the advice generated by the system. In the Office action, it is acknowledged that Burkey does not show this limitation. Claim 12 is

rejected for the same reasons as claim 7. Burkey fails to suggest the additional step of claim 12 for the reasons discussed above with respect to claim 7.

Applicants respectfully request for at least the above reasons that the rejection of claim 12 be withdrawn.

D. Independent Claim 13 and Claims Dependent Therefrom

In the Office action, it is asserted that claim 13 contains features addressed in previous claims, and therefore, is rejected under the same rationale. Claim 13 sets forth a system for providing financial payment advice specifically tailored to an individual's economic situation.

Burkey fails to suggest at least the following steps of claim 13 for reasons similar to those set forth above with respect to claim 1:

a graphical user interface (GUI) displayed on said display of said computer, said GUI comprising one or more descriptive icons, *said descriptive icons representing one or more financial situations*;

means for *generating financial payment advice* based at least in part on said information specific to said individual.

Burkey fails to show these elements for the reasons acknowledged in the Office action with respect to claim 1. There is no motivation found in the prior art to modify Burkey to include these elements. The unsupported statements in the Office action that it would have been obvious to modify Burkey to include the similar elements set forth in claim 1 are insufficient to establish a *prima facie* case of obviousness for the reasons discussed above.

Applicants respectfully request for at least the above reasons that the rejection of claim 13 as being unpatentable in view of Burkey be withdrawn.

Claims 14-16 depend from claim 13 and accordingly include all the limitations of claim 13. Claims 14-16 are thus patentable over Burkey for at least the reasons discussed above with respect to claim 13.

In addition, claim 14 sets forth means for generating advice on negotiation strategies for interacting with the individual. Claim 14 is rejected for the same reasons as claim 3. There is no suggestion or motivation, outside applicants' own specification, to modify Burkey

to generate advice on negotiation strategies for the reasons set forth above with respect to claim 3.

Claim 15 sets forth means for specifying the type of the advice generated by the system. Claim 15 is rejected for the same reasons as claim 7. Burkey fails to suggest the additional element of claim 15 for the reasons discussed above with respect to claim 7.

Claim 16 is not specifically addressed in the rejection over Burkey. Claim 16 sets forth that the system further comprises means for further refining the advice. Burkey fails to show or suggest such means for further refining the advice.

Applicants respectfully request for at least the above reasons that the rejections of claims 14-16 be withdrawn.

IV. CONCLUSION


The Office Action, reference, and rejections have been duly considered and addressed by the foregoing remarks. Reconsideration of the application and allowance are respectfully solicited.

Should the Examiner require resolution of any issues for allowance, the Examiner is invited to contact the undersigned to expedite the prosecution of this application to final action.

Respectfully submitted,

HUNTON & WILLIAMS

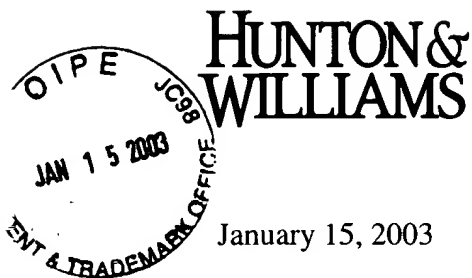
By:



Stephen T. Schreiner
Registration No. 43,097

Dated: January 15, 2003

Hunton & Williams
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)



January 15, 2003

1900 K STREET, N.W.
WASHINGTON, D.C. 20006-1109

TEL 202 • 955 • 1500
FAX 202 • 778 • 2201
Stephen T. Schreiner
Direct Dial: 202-955-1575
EMAIL: sschreiner@hunton.com

File No: 47004.000030

In re Patent Application of:

Barry BARTON, et al.

Application No.: 09/391,460

Filed: September 8, 1999

Title: FINANCIAL ADVICE AND STRATEGY SYSTEM

Attorney Docket No.: 47004.000030

Confirmation No.: 8639

Group Art Unit: 3628

Examiner: BUI, Thach H.

RECEIVED

JAN 16 2003

GROUP 3600

Commissioner for Patents
Washington, DC 20231

Transmitted herewith is an amendment in the above-identified application. Fees have been calculated as shown below:

CLAIMS AS AMENDED						
	Claims Remaining After Amendment	Highest Number Previously Paid For	Extra	Rate		Amount
				Large Entity	Small Entity	
Number of Claims in Excess of 20	16	20	0	\$ 18.00	\$ 9.00	\$ 0.00
Independent Claims in Excess of 3	4	4	0	\$ 84.00	\$ 42.00	\$ 0.00
First Presentation of Multiple Dependent Claims				\$ 280.00	\$ 140.00	\$ 0.00
Extension Fee: a) One Month				\$ 110.00	\$ 55.00	\$ 0.00
b) Two Months				\$ 400.00	\$ 200.00	\$ 0.00
c) Three Months				\$ 920.00	\$ 460.00	\$ 0.00
d) Four Months				\$1440.00	\$ 720.00	\$ 0.00
e) Five Months				\$1960.00	\$ 980.00	\$ 0.00
Other:						\$ 0.00
TOTAL FEE DUE						\$ 0.00

- ☒ No additional fee is required.
☐ A check in the amount of \$ _____ is attached.
☐ Charge \$ _____ to Deposit Account No. 50-0206.
☒ Charge any additional fees or credit any overpayment to Deposit Account No. 50-0206.

- ☐ Small Entity Status Claim:
is hereby requested.
☐ is of record in this application.

Respectfully submitted,



21967

PATENT TRADEMARK OFFICE

By:
Stephen T. Schreiner
Registration No. 43,097

STS/cal

ATLANTA AUSTIN BANGKOK BRUSSELS CHARLOTTE DALLAS HONG KONG KNOXVILLE LONDON
MCLEAN MIAMI NEW YORK NORFOLK RALEIGH RICHMOND WARSAW WASHINGTON

www.hunton.com